

REMARKS

Claims 1-38 and 62-67 are pending in the above-identified application. Claims 39-61 were previously cancelled. Claims 1-38 were rejected. With this Amendment, no claims were amended, added or cancelled. Accordingly, claims 1-38 and 62-67 remain at issue in the above-identified application.

I. 35 U.S.C. § 103 Obviousness Rejection of Claims

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,262,215 to Shields in view of U.S. Patent No. 6,110,317 to Sandor. Applicant respectfully traverses this rejection.

Shields is directed to a laminated article for having separable pieces for detachable placement on a background. The laminated article includes a web releasably adhered to a carrier sheet having indicia imprinted thereon. (See Abstract). The web includes a die cut top layer having indicia-imprinted separable pieces releasably adhered to a support layer. (See Abstract). Upon separating the web from the carrier sheet, selected ones of the separable pieces can be releasably attached to the carrier whereby the respective indicia cooperate for the playing of a game or creation of a scene. (See Abstract). For example, as depicted in Figure 4, the web comprises humorous facial features for cooperative placement on the corresponding facial outline seen as the indicia imprinted on the carrier sheet 14. (See column 2, lines 11-15).

Sandor is directed to a method for the production of decorative designs on substrates. (See Abstract). The method includes the steps of providing a design printed on a flat release sheet. (See Abstract). The design comprises a picture side in contact with the release surface and an exposed back side. (See Abstract). The exposed back side of the printed design is placed

in contact with the external substrate layer. (See Abstract). A liquid imprint coating material is applied to a surface, which becomes tacky after about 30 minutes. (See col. 3, lines 57-62). The design is placed on the tacky surface material, and a burnishing tool is used to transfer the image from the release paper onto the surface. (See col. 3, line 66 through col. 4, line 6). The design is imprinted into the substrate layer, and the release sheet is removed, leaving the design imprinted in the layer with its picture side exposed. (See Abstract).

Applicant respectfully disagrees with the Examiner that it would have been obvious to combine the teachings of Shields and Sandor to derive the claims of the present invention. The Examiner did not show that some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead one to combine a laminated article having separable pieces that can be releasably attached to the carrier whereby the respective indicia cooperate for the playing of a game or creation of a scene, as taught by Shields, with a design that is transferred onto a substrate, as taught by Sandor. Thus, Applicant respectfully submits that a prima facie case of obviousness was not established. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984)). Neither of the cited references suggests any motivation for, or the desirability of, the changes espoused here by the Examiner.

Moreover, Sandor teaches that the decorative design 2 has a flat positive image first surface 10 in contact with the release surface 8, and an exposed flat mirror image second surface 12. (See col. 7, lines 57-62). Thus, Sandor teaches a decorative design having an image that

appears on both surfaces of the design. Sandor does not teach "two images coinciding with each other on a surface," as suggested by the Examiner. If one were to modify the laminated article of Shields to include the two images of Sandor, the image would appear on both surfaces of the laminated article. The combination would not result in the decal sheet having the layers required by claim 1.

Because claim 1 includes limitations that are neither disclosed nor suggested by Shields or Sandor, claim 1, and claims 2-12 that depend from claim 1, are allowable over Shields in view of Sandor. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claims 13-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,262,215 to Shields in view of U.S. Patent No. 6,110,317 to Sandor. Applicant respectfully traverses this rejection.

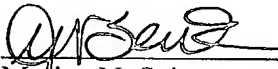
As discussed above, none of the cited references suggests any motivation for, or the desirability of, combining the teachings of Shields and Sandor. In addition, if one were to modify the laminated article of Shields to include the two images of Sandor, the combination would not result in the decal sheet having the layers required by claims 13-38. Accordingly, Applicant respectfully requests withdrawal of this rejection.

II. Conclusion

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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